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LERNER, DAVID, LITTENBERG, KRUMHOLZ & MENTLIK 600 SOUTH AVENUE WEST WESTFIELD, NJ 07090			REIMERS, ANNETTE R	
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			3733	

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/679,569
Filing Date: October 6, 2003
Appellant(s): COLLAZO C.E.

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MAY 04 2006
GROUP 3700

Raymond W. Augustin
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 17, 2006 appealing from the Office action mailed August 11, 2005.

(1) Real Part of Interest

A statement identifying the real part in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings, which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

No amendment after final has been filed.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal in the brief are substantially correct. 1. Whether claims 12-16, 18 and 20-22 are patentable under 35 U.S.C. § 102 (3) (sic. b) or being anticipated by Ceniz U.S. Patent No. 3,981,604.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

3,981,604	Cenis	9-1976
20030163151	Ball et al.	8-2003

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 12-16, 18 and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Cenis (U.S. Patent Number 3,981,604).

Cenis discloses a cylindrical bushing, e.g. figure 2, comprising a cylindrical body with an outer bearing surface, e.g. 21 of figures 2 and 3, for rotatably engaging a surface of the fixture in which the bushing is mounted, the outer bearing surface extending circumferentially around an outer cylindrical surface of

the bushing, a longitudinal bore formed in the body (see figure 2) and a plurality of recesses extending radially outward from the bushing central bore, e.g. 22 of figure 2. In addition, the cylindrical outer bearing surface extends about an axis, which is coaxial with an axis of the longitudinal bore (see figures 2 and 3).

Each recess is capable of receiving at least two flutes (see figures 2, 4, and 5). Furthermore, the recesses are capable of extending a distance greater than a largest radial extent of the flutes of the at least two reamers, since the Cenis bushing device can accommodate any reamer design having straight flutes (see figures 2, 4 and 5). Moreover, the bushing is capable of having a number of recesses equal to or greater than the number of flutes of each of the reamers (see figures 2, 4, and 5). In addition, the recesses and the flutes expand in width on moving radially outward from the bushing body longitudinal bore or the inner shaft, respectively (see figure 4).

Claims 12-14, 18 and 20-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Ball et al. (U.S. Patent Publication 2003/0163151).

Ball et al. disclose a cylindrical bushing, e.g. figure 4, comprising a cylindrical body with an outer bearing surface, e.g. 23 of figure 4, for rotatably engaging a surface of the fixture in which the bushing is mounted, the outer bearing surface extending circumferentially around an outer cylindrical surface of the bushing, a longitudinal bore formed in the body (see figure 4) and a plurality of recesses extending radially outward from the bushing central bore, (see figure

4). In addition, the cylindrical outer bearing surface extends about an axis, which is coaxial with an axis of the longitudinal bore (see figures 4 and 5).

Each recess is capable of receiving at least two flutes (see figure 4). Furthermore, the recesses are capable of extending a distance greater than a largest radial extent of the flutes of the at least two reamers, since the Ball bushing device can accommodate any reamer design having straight flutes (see figure 4). Moreover, the bushing is capable of having a number of recesses equal to or greater than the number of flutes of each of the reamers (see figure 4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cenis (U.S. Patent Number 3,981,604).

Cenis discloses the claimed invention except for where the plurality of recesses have radial ends opposite ends thereof open to the bore at a shorter radial distance from the axis of the longitudinal bore than the outer cylindrical surface of the bushing. It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct the device of Cenis where the plurality of recesses have radial ends opposite ends thereof open to the bore

at a shorter radial distance from the axis of the longitudinal bore than the outer cylindrical surface of the bushing, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

(10) Response to Argument

Appellant raises a number of issues in his brief, which require rebuttal in this examiner's answer.

In response to Appellant's argument that the bushing of the *Cenis* reference does not rotate. Appellant has disclosed rotation as an intended use, i.e. functional language, not a structural limitation. With regard to statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over *Cenis*, which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). In addition, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Therefore, *Cenis* only has to be capable of rotation, which the bushing of *Cenis* is capable of rotation, if one so desires. Moreover, it has been held that the

recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138. Regarding Appellant's argument that the bushing of Ceniz is press-fit or glued, Ceniz teaches that the bushing may, not shall, be press-fitted or glued to the plate (see column 1, lines 10-13).

Regarding the preamble of claim 12, the recitation that a reamer bushing mounted in a fixture adapted for being aligned with a bone canal, the bushing for use with at least two different diameter rotatable bone reamers, the reamers each having a plurality of longitudinal flutes extending from an inner shaft, outer radial ends of the flutes defining the reamer diameter has not been given patentable weight, because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. Kropa v. Robie, 88 USPQ 478 (CCPA 1951).

Appellant is structurally claiming the combination of a reamer bushing and a fixture, everything else recited in the preamble, including the information regarding the rotatable bone reamers is functional, i.e. the bushing **for use with at least two different diameter rotatable bone reamers**. With regard to statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Ceniz, which is

capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). In addition, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). *Cenis* discloses the structurally claimed reamer bushing with an outer bearing surface, 21, and a fixture, e.g. 14, (see figures 1-3 and column 3, lines 14-17). Therefore, *Cenis* only has to be capable of being used with at least two different diameter rotatable bone reamers, which the bushing of *Cenis* is capable of being used with at least two different diameter rotatable bone reamers, if one so desires. Moreover, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Examiner respectfully disagrees with Appellant that *Ball et al.* fails to disclose a non-rotatable bushing, since *Ball et al.* teaches a rotatable bushing, i.e. moveable in different orientations (see paragraphs 0039-0041). Furthermore, Appellant has disclosed rotation as an intended use, i.e. functional language, not a structural limitation. With regard to statements of intended use and other

functional statements, they do not impose any structural limitations on the claims distinguishable over Ball et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). In addition, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Therefore, Ball et al. only has to be capable of rotation, which the bushing of Ball et al. is capable of rotation, if one so desires. Moreover, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

Regarding the preamble of claim 12, the recitation that a reamer bushing mounted in a fixture adapted for being aligned with a bone canal, the bushing for use with at least two different diameter rotatable bone reamers, the reamers each having a plurality of longitudinal flutes extending from an inner shaft, outer radial ends of the flutes defining the reamer diameter has not been given patentable weight, because it has been held that a preamble is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim

following the preamble is a self-contained description of the structure not depending for completeness upon the introductory clause. *Kropa v. Robie*, 88 USPQ 478 (CCPA 1951).

Appellant is structurally claiming the combination of a reamer bushing and a fixture, everything else recited in the preamble, including the information regarding the rotatable bone reamers is functional, i.e. the bushing **for use with at least two different diameter rotatable bone reamers**. With regard to statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over Ball et al., which is capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). In addition, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Ball et al. disclose the structurally claimed reamer bushing with an outer bearing surface, 23, and a fixture, e.g. 60, (see figures 3 and 4). Therefore, Ball et al. only has to be capable of being used with at least two different diameter rotatable bone reamers, which the bushing of Ball et al. is capable of being used with at least two different diameter rotatable bone

reamers, if one so desires. Moreover, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchison*, 69 USPQ 138.

In response to Appellant's argument that neither *Cenis* nor *Ball et al.* relate to preparing a bone canal. With regard to statements of intended use and other functional statements, they do not impose any structural limitations on the claims distinguishable over *Cenis* or *Ball et al.*, both of which are capable of being used as claimed if one so desires to do so. *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). Furthermore, the law of anticipation does not require that the reference "teach" what the subject patent teaches, but rather it is only necessary that the claims under attack "read on" something in the reference. *Kalman v. Kimberly Clark Corp.*, 218 USPQ 781 (CCPA 1983). In addition, the manner in which a device is intended to be employed does not differentiate the claimed apparatus from prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Therefore, the *Cenis* and *Ball et al.* references only have to be capable of preparing a bone canal, which the bushings disclosed in *Cenis* and *Ball et al.* are capable of preparing a bone canal, if one so desires. Moreover, it has been held that the recitation that an element is "capable of" performing a function is not a positive limitation but only requires the ability to so

perform. It does not constitute a limitation in any patentable sense. In re Hutchison, 69 USPQ 138.

Regarding claims 23 and 24, in response to Appellant's argument that the machine tool art is nonanalogous art, it has been held that the determination that a reference is from a nonanalogous art is twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved. In re Wood, 202 USPQ 171, 174. In this case, the Appellant is structurally claiming the combination of a reamer bushing and a fixture. The Cenis reference meets these structural limitations (see explanations above).

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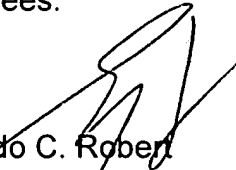
(11) Related Proceeding(s) Appendix

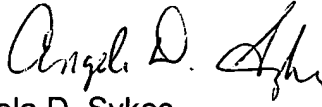
No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer. For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


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Examiner
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